officially or unofficially reported. Its ruling on this issue is reproduced at pages 247a-250a.

The reference in the Petition (p. 1) to the District Court's opinion in the United States Patent Quarterly, 154 U.S. P.Q. 226, is to an opinion by another Judge on plaintiff's motion for a preliminary injunction, a matter which is not the subject of the Petition.

The opinion of the United States Court of Appeals for the Second Circuit, written by Circuit Judge Feinberg and concurred in by Chief Judge Lumbard and Circuit Judge Anderson, has been officially reported at 433 F.2d 409 (2d Cir. 1970) and unofficially reported in the United States Patent Quarterly at 167 U.S.P.Q. 417. It appears at A1-A11.

Statement of the Case

This is an action for copyright infringement under Title 17, U.S. Code. Federal jurisdiction is based on 28 U.S.C. Section 1338. The subject of the copyrights in question is a "work of art" (17 U.S.C. Section 5(g)) embodied in a lace design. Petitioner used a sample of Respondent's fabric to produce the same "look" in a lace for use interchangeably with Respondent's lace (R. 84; 84a). During all pertinent times, Respondent sold its design exclusively to one customer (R. 28; 43a) and Petitioner sold its infringing pattern only to the same customer for use in the same end product (Weiner Affidavit, p. 1; 251a; and R. 100; 96a).

The District Court held Respondent's two copyrights valid and infringed, granted an injunction and ordered the destruction of infringing matter. The Court also awarded

Respondent its damages of $22,593.34, as well as Petitioner's profits of $61,618.20, for a judgment of $84,211.54, together with costs.

Reasons for Denying Writ

The issues usually most troublesome in copyright cases are not present in this infringement action. For example, absent is the question whether the defendant copied from the plaintiff's work, as opposed to duplicating it independently. Petitioner here admittedly used Respondent's lace design as a model for its production of its competitive design (R. 172; 153a). The resulting similarity appears on the face of the two designs and is further supported by the fact that the laces of Petitioner and Respondent were used interchangeably by the same customer for the same item (R. 100; 96a). This latter fact also makes the issue of damage somewhat unique since sales made by Petitioner are indisputably sales Respondent could have made in the absence of the infringement.

The absence of traditionally difficult copyright issues was noted in the statement of the Court of Appeals that "the case, therefore, is an unusual one. There is no question of access; the fact of copying is now clear." The Court also noted that because of the interchangeability of the two lace patterns, "we do not have the more obvious problems on damage."

The essential simplicity of this action has posed severe problems for Petitioner in seeking review from this Court. These difficulties pervade the Petition for certiorari and call for its denial.

I.

At the outset, Petitioner seeks to raise a question as to compliance by Respondent with the notice requirements of Section 10 of the Copyright Law, 17 U.S.C. Section 10 (Question 1). Petitioner seeks to raise this issue by arguing that Respondent affixed the notice on some of its lace in an insufficient manner. It is, however, crystal clear that the issue is not raised by the record in this case. The District Court made no finding on which Petitioner can raise this question and the Court of Appeals expressly found that the record did not permit such argument (A4-A5). Respondent had introduced evidence of a *prima facie* valid copyright and *prima facie* compliance with the notice requirements of the Copyright Law. As correctly noted by the Court of Appeals, "thereafter, the burden of establishing that plaintiff labelled and shipped its lace with insufficient notice rested on defendant. Defendant offered little evidence on this precise issue and failed to meet that burden, apparently because it did not press the point before Judge Tyler." (A4-A5)*

That this notice issue was not in the case was further confirmed at the trial when Respondent attempted to offer evidence to amplify the record with regard to its compliance with the notice provision. Such amplification was halted by the District Court, upon Petitioner's objection, on the ground that it was not relevant to any defense effectively raised by Petitioner (R. 38-39; 51a).

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* Perhaps Petitioner was embarrassed in sustaining this burden by the fact that Petitioner itself applied notice to its lace in precisely the same manner as Respondent and proceeded to secure a copyright registration of its own on this basis (R. 159-60; 144a; Pltf. Ex. 17).

II.

It is not at all clear from the discussion of Question II in the Petition what award of monetary relief Petitioner argues would have been appropriate. From the authorities cited by Petitioner, however, it appears that Petitioner is essentially asking that this Court reduce the judgment of $84,211.54 to $61,618.20. Instead of the award of $22,593.34 as the "damages" suffered by Respondent "as well as" the $61,618.20 as the "profits" which Petitioner made from the infringement, Petitioner in effect seeks that only the latter figure be awarded. This Court should do this, Petitioner argues, by imposing a judicial gloss on the explicit remedial provision of the Copyright Law, which provides that the infringer shall pay to the copyright proprietor "such damage as the copyright proprietor may have suffered due to the infringement, as well as the profits which the infringer shall have made from such infringement." 17 U.S.C. 101(b). Petitioner would have this Court change "as well as" to "or" and add to the end of this statutory language the words "whichever is greater."

It is submitted that this question is also inappropriate for review. This is so for a number of reasons, even aside from the fact that the District Court and Court of Appeals were correct in applying this provision according to its language.*

A. Question II is stated by Petitioner to involve two subquestions: (a) whether Section 101(b) makes it mandatory to award damages "as well as" profits, and (b) if such an award is not mandatory, whether it was appropriate to make it on the facts of this case.

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* See, e.g., *Peter Pan Fabrics, Inc.* v. *Jobela Fabrics, Inc.*, 329 F.2d 194 (2d Cir. 1964).

The first sub-question, once again, may not even be involved in this case. The Court of Appeals here relied upon its earlier decisions in *Peter Pan Fabrics, Inc.* v. *Jobela Fabrics, Inc.*, 329 F.2d 194 (2d Cir. 1964), and *Alouf* v. *Expansion Products, Inc.*, 417 F.2d 767 (2d Cir. 1969). In the Court of Appeals, Petitioner conceded that under the *Jobela* case "there *may* be a cumulative recovery of damages and defendant's profits." (Appellant's Brief, p. 22). [Emphasis in original] In the present action, it was unnecessary for the Court of Appeals to decide that such an award was mandatory. Thus, the opinion stated that "Judge Tyler *could* award both items of damage, as he did." (A9) [Emphasis added.]

B. Even if the language of the statute required clarification in some other context, the present case is so unusual as to make review inappropriate here. As noted above, the fact that Petitioner and Respondent were selling the same lace to the same customer for the same purpose makes it obvious that what the customer purchased from Petitioner, the customer would have bought from Respondent had Petitioner not infringed. This is one of the few reported cases, if not the only one, in which this situation has been present. In the case law, there is generally a question beclouding the amount of damages suffered by the plaintiff, because it is almost always uncertain whether the sales made by the defendant would have been made by plaintiff but for the infringement. This difficulty does not exist in this case and, therefore, there is not present the usual element of a cumulating of actual profits with damages which are speculative.

In view of the foregoing, it is submitted that the factual peculiarities of the present case make it an inapt vehicle for consideration of factors generally relevant to the statutory remedy in Section 101(b).

C. Petitioner argues that "Question II presents an issue of conflict between the United States Court of Appeals for the Second Circuit and the United States Court of Appeals for the Sixth and Ninth Circuits, regarding the application of the copyright statute, Section 101(b) providing for remedies in an infringement of copyright." (Petition, p. 13).

In fact, the United States Court of Appeals for the Sixth Circuit has never addressed itself to the issue being raised by Question II. In *Gordon* v. *Weir*, 111 F. Supp. 117 (E.D. Mich. 1953), the United States District Court for the Eastern District of Michigan did state, by way of dictum, that a copyright proprietor is entitled to recover either actual damages or profits, whichever is greater. But in that case, there was *no* proof of defendant's profits or even his sales, so there could have been no award of profits in that case. Even more significant, however, is the fact that on appeal, the question of damages was nowhere raised in the briefs. Accordingly, in affirming, 216 F.2d 508 (6th Cir. 1954), the Court of Appeals did not have an opportunity to rule on the subject under consideration.

In *Universal Pictures Co.* v. *Harold Lloyd Corp.*, 162 F. 2d 354 (9th Cir. 1947), the situation was also distinguishable from the present case in that plaintiff's damages were greater than defendant's profits. By requiring the payment of the greater amount represented by plaintiff's damages, the District Court there was able to require the defendant to do more than merely disgorge its profits, and

thus the Court achieved the important deterrent effect contemplated by the statute. And the Court of Appeals for the Ninth Circuit did not expressly hold that the District Court *could not* award both damages and profits, but only that under the circumstances the trial court was justified in declining to award both.

Thus, there is no conflict of Circuits on the question tendered by Petitioner.

D. Aside from the foregoing reasons warranting denial of certiorari, it is submitted that the Court below was clearly justified in permitting the District Judge to apply the words of the statute. The deterrent policy of Section 101(b) would be hampered if it did not authorize the trial court to make such award, as this Court explained in another context involving copyright damages:

> "[A] rule of liability which merely takes away the profits from an infringement would offer little discouragement to infringers. It would fall short of an effective sanction for enforcement of the copyright policy. The statutory rule, formulated after long experience, not merely compels restitution of profit and reparation for injury but also is designed to discourage wrongful conduct." *F. W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, 233 (1952).

This reasoning is equally applicable to the situation at hand. Moreover, as noted by the Court below: "The Congress is not unaware of the problem, since proposals to modify this aspect of the statute have been pending there for some time." (A8) It is thus apparent that alteration of the clear words of the statute may be accomplished by Congress if it sees fit, in the context of the proposals pres-

ently pending for a general revision of the copyright law. See, e.g. S.543, 91st Cong. 1st Sess. (1969); S.644 92d Cong. 1st Sess. (1971).

III.

Petitioner argues that "this Court has never decided this important issue of recurring significance in the application of the copyright laws as to the quantum of creativity and originality in a 'work of art', which is necessary to support the copyright registration." (Petition, p. 21).

It is submitted that under the decisions of this Court, the result in the present case is perfectly clear. At the turn of the century, Mr. Justice Holmes found that copyright was available for "a very modest grade of art [which] has in it something irreducible, which is one man's alone." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 at 250 (1903). With regard to the commercial nature of the circus poster involved in *Bleistein*, Mr. Justice Holmes set forth his often quoted dictum that "it would be a dangerous undertaking for persons trained only to the law to constitute themselves the final judges of the worth of pictorial illustration, outside of the narrowest and most obvious limits . . . That these pictures have their worth and value is sufficiently shown by the desire to reproduce them without regard to the plaintiff's rights." *Id.* at 251-52.

More recently this Court has had before it other examples of "art" in commercial settings. For example, in *F. W. Woolworth v. Contemporary Arts, Inc., supra*, the Court approved the award of damages for the infringement of copyright in a plaster statuette of a typical cocker spaniel in the stylized pose known as "show position."

And in *Mazer* v. *Stein*, 347 U.S. 201 (1954), the Court was faced squarely with the question of the validity of copyright in statuettes intended primarily for use as lamp bases. In upholding the copyright, Mr. Justice Reed noted that "individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art . . . Such expression [of the author's ideas], whether meticulously delineating the model or mental image or conveying meaning by modernistic form or color, is copyrightable." 347 U.S. at 214.

It is beyond question that the floral designs involved in this case, created by a professional lace designer trained in lace design at the Nottingham College of Art (R. 69; 73a) is a work of art entitled to copyright protection. *Tennessee Fabricating Co.* v. *Moultrie Mfg. Co.*, 421 F.2d 279 (5th Cir.), *cert. denied*, 389 U.S. 928 (1970).* *Alfred Bell & Co., Ltd.* v. *Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); *Doran* v. *Sunset House Distributing Corp.*, 304 F.2d 251 (9th Cir. 1962); *Prestige Floral* v. *California Artificial Flower Co.*, 201 F. Supp. 287 (S.D.N.Y. 1962); *Peter Pan Fabrics* v. *Candy Frocks, Inc.*, 187 F. Supp. 334 (S.D. N.Y. 1960).

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* It may be noted that the District Court decision in the *Tennessee Fabricating* case was cited in a 1969 report quoted on page 22 of the Petition for the proposition that the work there involved did not possess the minimal degree of copyrightability required of a work of art. This proposition was rejected by the Court of Appeals for the Fifth Circuit, which reversed that District Court decision.

IV.

Petitioner argues that the District Court's monetary award, based on the record and applicable precedents, and unanimously affirmed by the Court of Appeals, "is so unconscionably punitive of Petitioner and so unreasonably unjust an enrichment of the Respondent . . . as to indicate that the Court of Appeals has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power to supervise under Rule 19(b) of the Rules of this Court." (Petition, pp. 22-23). Rule 19(b), designed to redress egregious departures from proper proceedings, is totally inapplicable to this routine affirmance of a copyright infringement judgment.

CONCLUSION

For all of the foregoing reasons, it is submitted that this case does not warrant review by this Court, and that the petition for certiorari should accordingly be denied.

Respectfully submitted,

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